



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,534	08/03/2001	Richard B. Himmelstein	4159-4003US2	6981

7590 03/13/2003

Walter G. Hanchuk
Morgan & Finnegan, LLP
345 Park Avenue
New York, NY 10154

EXAMINER

BACKER, FIRMIN

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SL

Office Action Summary	Application No. 09/921,534	Applicant(s) HIMMELSTEIN, RICHARD B.	
	Examiner Firmin Backer	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Art Unit: 3621

Response to Request for Reconsideration

This is in response to a request for reconsideration file December 27th, 2002. Claims 1-27 are being reconsidered in this action.

Response to Arguments

1. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2. Claims 1, 14, 15 and 17 are objected to because of the following informalities: Applicant discloses "*the internet*" in paragraph 7 line 1. Applicant is advised to delete the word "*the*" in order to overcome Examiner's objection. Appropriate correction is required.

3. Claim 1 is objected to because of the following informalities: Applicant discloses "*such a*" in paragraph 4 line 5. Applicant is advised to delete the word "*such*" in order to overcome Examiner's objection.

Art Unit: 3621

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 10, 16 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. In particular, claims 1, 10, 16 and 24 the phrase "may" renders the claims indefinite because, it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Claims 1, 10, 16 and 24 are rejected as being dependent on a rejected base claim.

Double Patenting

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefore ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Art Unit: 3621

8. Claims 1-13 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 09/666,725. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 14-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/666,725. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both define inventions that are obvious variations of each other and achieving the same end result. Accordingly, it would have been obvious to those in possession of the inventive concept disclosed in claims 14-24 are already included in the inventive concept disclosed in claim 1 of copending application 09/666,725. Furthermore, one of ordinary skill in the art at the time the invention was made would have realized the omission of *"means for designating a date range for transferring title of the selected quantity of the first class of items to be bartered whereby a barterer may elect to defer the transfer of title to the first*

Art Unit: 3621

class items to a time after the barter order is used to complete a barter transaction or elect to transfer title along with the completion of such barter transaction” in claims 14, 15 and 17, and the addition of “means for matching a plurality of barter such that the first class of item of each barter of the plurality of barter orders matches the second class of items of the different barter order of the plurality of barter order”, “finalizing a barter transaction based on the barter’s order and the selected barter” in claim 14 and 15 respectively of the copending application are obvious expedient since the remaining element are defined in the claims. In re Karlson, 136 USPQ 184 (CCPA 1963).

11. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claim 1-20 and 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Minton (U.S. PG Pub 2002/0091611 A1).

Art Unit: 3621

14. As per claim 1, Minton teaches a bartering system for implementing barter between a plurality of parties each having one or more classes of items available for barter (*data processing system (20) for allowing individual to buy and sell securities*) (see fig 1, 2, 3, page paragraph 0014) comprising means (*server, 316*) for creating a barter order (*buys and sell orders*) (fig 3, page 4 paragraph 0053) including means for designating a selected quantity (*quantity*) of a first class of items (*securities*) to be bartered (*to be traded*) (fig 3, page 4 paragraph 0053), means for designating a date range (*time*) for transferring title (*transmitting title*) of the selected quantity (*quantity of securities*) of the first class of items to be bartered whereby a barterer may elect to defer the transfer of title to the first class items to a time after the barter order is used to complete a barter transaction or elect to transfer title (*transmitting title*) along with the completion of such barter transaction (see abstract, page 2 paragraph 0016, claim 16), means for designating a barter value (*the price*) of the first class of items to be bartered (fig 3, page 4 paragraph 0053), and means for designating a second class of items (*securities*) to be acquired (*bought*) (fig 3, page 4 paragraph 0053) means for posting (*displaying order*) barter orders (*order to buy and sell*) via the internet (*public network*) to a barter database (see figs 1, 3 page 4 paragraph 0055, 0056), means for displaying (*display 96*) via the internet posted barter orders whose first class of items match the second class of items of a barterer's order (see page 4 paragraph 0056), and means for selecting (*matching and executing*) a posted barter order from the displaying means to effectuate a barter transaction which combines a barterer's barter order with the selected posted order (paragraph 0057, 0069).

Art Unit: 3621

15. As per claim 2, Minton teaches a bartering system wherein the means for creating a barter order further includes means for designating a quantity and a barter value of the second class of items and means for calculating and displaying a value ratio based on the barter value of the first class items and the second class items (*see fig 4, paragraph 0053, 0062*).

16. As per claim 3, Minton teaches a bartering system wherein the barter value designating means includes means for designating a variable value for a barter order based on market value and the displaying means recalculates variable barter values for barter orders which are displayed (*see fig 4, paragraph 0053, 0062*).

17. As per claim 4, Minton teaches a bartering system wherein the means for creating a barter order further includes means for designating a value ratio between designated quantities of first class items and second class items of a barter order and the means for displaying displays barter orders having a value ratios within a selected range (*see fig 4*).

18. As per claim 5, Minton teaches a bartering system wherein the means for displaying displays barter orders based on the designated date ranges (*see fig 4*).

19. As per claim 6, Minton teaches a bartering system wherein the means for creating a bartering order further includes means for designating applicable dividend reinvestment preferences for the first class and second class items and the means for displaying displays barter orders having first class items with a designated dividend preference which corresponds with the

Art Unit: 3621

dividend preference of the second class items of the barterer's order (*see fig 4, paragraph 0053, 0062*).

20. As per claim 7, Minton teaches a bartering system wherein the means for designating barter values of the first class and the second class items permits a barter value range and the means for displaying displays barter orders having first class items with barter values or ranges of barter values which fall within a selected range of values which includes the barter value or value range of the second class items of the barterer's order (*see figs 4, 6, 7*).

21. As per claim 8, Minton teaches a bartering system wherein the means for creating a barter order further includes means for accessing records related to current market value of the first class of items (*see fig 5*).

22. As per claim 9, Minton teaches a bartering system wherein the means for displaying displays a plurality of barter orders arranged by ratio to stock trading price, value ratio or percentage (*see fig 4, paragraph 0062*).

23. As per claim 10, Minton teaches a bartering system wherein the item classes include different categories such as stock, stock options, specified rights in stocks, notes, certificate of deposit, bonds and barter dollars and. wherein a barter order's first class items may be a different category than the second class items of that order (*see fig 4, paragraph 0004*).

Art Unit: 3621

24. As per claim 11, Minton teaches a bartering system wherein the item classes are limited to stock and wherein barter order first and second class items are two different stocks (*see fig 4, paragraph 0007*).

25. As per claim 12, Minton teaches a bartering system further comprising means for tracking barter transactions for reporting taxable events attributable to respective barter orders of a plurality of barter transactions (*see fig 4*).

26. As per claim 13, Minton teaches a bartering system further comprises means for concluding a barter transaction based on the barterer's order and a selected posted barter order, identifying residual amounts reflective of value disparity between the orders of the transaction, and designating a recipient of the residual amounts (*see fig 4*).

27. As per claim 14, Minton teaches a bartering system for implementing barterers between a plurality of parties each having one or more classes of items available for barter (*data processing system (20) for allowing individual to buy and sell securities*) (*see fig 1, 2, 3, page paragraph 0014*) comprising means (*server, 316*) for creating a barter order (*buys and sell orders*) (*fig 3, page 4 paragraph 0053*) including means for designating a selected quantity (*quantity*) of a first class of items (*securities*) to be bartered (*to be traded*) (*fig 3, page 4 paragraph 0053*), means for designating a barter value (*the price*) of the first class of items to be bartered (*fig 3, page 4 paragraph 0053*), and means for designating a second class of items (*securities*) to be acquired (*bought*) (*fig 3, page 4 paragraph 0053*) means for posting (*displaying order*) barter orders

Art Unit: 3621

(order to buy and sell) via the internet *(public network)* to a barter database *(see figs 1, 3 page 4 paragraph 0055, 0056)*, means for matching *(matching and executing)* a plurality of barter such that the first class of item of each barter of the plurality of barter orders matches the second class of items of the different barter order of the plurality of barter order *(paragraph 0057, 0069)*.

28. As per claim 15, Minton teaches a method of bartering *(data processing system (20) for allowing individual to buy and sell securities)* *(see fig 1, 2, 3, page paragraph 0014)* comprising creating a barter order *(buys and sell orders)* *(fig 3, page 4 paragraph 0053)* including designating a selected quantity *(quantity)* of a first class of items *(securities)* to be bartered *(to be traded)* *(fig 3, page 4 paragraph 0053)*, designating a barter value *(the price)* of the first class of items to be bartered *(fig 3, page 4 paragraph 0053)*, and designating a second class of items *(securities)* to be acquired *(bought)* *(fig 3, page 4 paragraph 0053)* posting *(displaying order)* barter orders *(order to buy and sell)* via the internet *(public network)* to a barter database *(see figs 1, 3 page 4 paragraph 0055, 0056)*, displaying *(display 96)* via the internet posted barter orders whose first class of items match the second class of items of a barterer's order *(see page 4 paragraph 0056)*, selecting *(matching and executing)* a barter order from the displaying and finalizing a barter transaction based on the barter's order and the selected barter *(paragraph 0057, 0069)*.

29. As per claim 16, Minton teaches a method wherein creating a barter order includes means for designating a date range for transferring title of the selected quantity of the first class of items to be bartered whereby a barterer may elect to defer the transfer of title to the first class items to

Art Unit: 3621

a time after the barter order is used to complete a barter transaction or elect to transfer title along with the completion of such a barter transaction (*see abstract, page 2 paragraph 0016, claim 16*).

30. As per claim 17, Minton teaches a bartering system for implementing barter between a plurality of parties each having one or more classes of items available for barter (*data processing system (20) for allowing individual to buy and sell securities*) (*see fig 1, 2, 3, page paragraph 0014*) comprising means (*server, 316*) for creating a barter order (*buys and sell orders*) (*fig 3, page 4 paragraph 0053*) including means for designating a selected quantity (*quantity*) of a first class of items (*securities*) to be bartered (*to be traded*) (*fig 3, page 4 paragraph 0053*), means for designating a barter value (*the price*) of the first class of items to be bartered (*fig 3, page 4 paragraph 0053*), and means for designating a second class of items (*securities*) to be acquired (*bought*) (*fig 3, page 4 paragraph 0053*) means for posting (*displaying order*) barter orders (*order to buy and sell*) via the internet (*public network*) to a barter database (*see figs 1, 3 page 4 paragraph 0055, 0056*), means for displaying (*display 96*) via the internet posted barter orders whose first class of items match the second class of items of a barterer's order (*see page 4 paragraph 0056*), and means for selecting (*matching and executing*) a posted barter order from the displaying means (*paragraph 0057, 0069*).

31. As per claim 18, Minton teaches a bartering system wherein the means for creating a barter order further includes means for designating a quantity and a barter value of the second class of items and means for calculating and displaying a value ratio based on the barter value of the first class items and the second class items (*see fig 4, paragraph 0062*).

Art Unit: 3621

32. As per claim 19, Minton teaches a bartering system wherein the value ratio is calculated based upon a combination of the ratios x/y and a/b where: a = the barter value of the first class of items to be bartered, b = a market price of the first class items to be bartered, x = the barter value of the second class of items to be acquired and y = a market price of the second class items to be acquired (*see fig 4, paragraph 0062*).

33. As per claim 20, Minton teaches a bartering system further comprising means for selecting a desired formula from among a plurality of formulas to calculate the value ratio (*see fig 4, paragraph 0062*).

34. As per claim 24, Minton teaches a bartering system where the means for creating a barter order further includes means for designating a quantity and a barter value of the second class of items such that fractional values of the quantities of the first class items and the second class items may be selected (*see fig 4, paragraph 0053, 0062*).

35. As per claim 25, Minton teaches a bartering system where the means for creating a barter order further includes means for designating a quantity and a barter value of the second class of items such that fractional values of the quantities of the first class items and the second class items may be selected (*see fig 4, paragraph 0053, 0062*).

Art Unit: 3621

36. As per claim 26, Minton teaches a bartering system wherein the value ratio is calculated based on a combination of the ratios x/y and a/b where: a = the barter value of the first class of items to be bartered, b = a market price of the first class items to be bartered, x = the barter value of the second class of items to be acquired and y = a market price of the second class items to be acquired (*see fig 4, paragraph 0053, 0062*).

37. As per claim 27, Minton teaches a bartering system further comprising means for selecting a desired formula from among a plurality of formulas to calculate the value ratio (*see fig 4, paragraph 0053, 0062*).

Allowable Subject Matter

38. Claims 21-23 are objected to as being dependent upon a rejected base claim, but would be allowable if the provisional double patenting rejection is overcome and if the claims are rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

39. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. *Hawkins et al (6,247,000) teach method of matching a plurality of predetermined financial transactions for a plurality of users, wherein data for the plurality of predetermined financial transactions.*

Art Unit: 3621

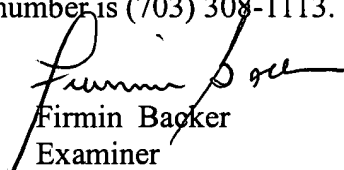
b. *Hawkins et al (U.S. Patent No. 6,029,146) teach a system and method for direct broker to broker trading that will automatically match an investor's security order with an executing broker's match confirmation and will automatically generate and route via the SWIFT Financial Network a settlement instruction to the investor's clearing agent.*

c. *Minton (U.S. Patent No. 6,014,643) teach a data processing system, and a network of data processing systems for allowing individuals to buy and sell securities directly from other individuals, with only minimal oversight by a broker.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Firmin Backer
Examiner
Art Unit 3621

March 4, 2003